

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference 3682.1001005	FOR FURTHER ACTION		See item 4 below
International application No. PCT/US2006/014584	International filing date (<i>day/month/year</i>) 19 April 2006 (19.04.2006)	Priority date (<i>day/month/year</i>) 21 April 2005 (21.04.2005)	
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237			
Applicant GRYPHON NETWORKS			

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 *bis*.1(a).

2. This REPORT consists of a total of 8 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- | | | |
|-------------------------------------|--------------|---|
| <input checked="" type="checkbox"/> | Box No. I | Basis of the report |
| <input type="checkbox"/> | Box No. II | Priority |
| <input type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> | Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> | Box No. VI | Certain documents cited |
| <input checked="" type="checkbox"/> | Box No. VII | Certain defects in the international application |
| <input checked="" type="checkbox"/> | Box No. VIII | Certain observations on the international application |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Date of issuance of this report 23 October 2007 (23.10.2007)
Facsimile No. +41 22 338 82 70	Authorized officer <div style="text-align: center; font-weight: bold; font-size: 1.2em;">Simin Baharlou</div> e-mail: pt09.pct@wipo.int

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PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

To:

see form PCT/ISA/220

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)

Date of mailing
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference
see form PCT/ISA/220

FOR FURTHER ACTION
See paragraph 2 below

International application No.
PCT/US2006/014584

International filing date (day/month/year)
19.04.2006

Priority date (day/month/year)
21.04.2005

International Patent Classification (IPC) or both national classification and IPC
INV. H04M3/51 H04M3/38

Applicant
GRYPHON NETWORKS

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☒ Box No. VII Certain defects in the international application
- ☒ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA:



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Date of completion of
this opinion

see form
PCT/ISA/210

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**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US2006/014584

Box No. I Basis of the opinion

1. With regard to the **language**, this opinion has been established on the basis of:
 - ☒ the international application in the language in which it was filed
 - ☐ a translation of the international application into , which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1 (b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material:
 - ☐ a sequence listing
 - ☐ table(s) related to the sequence listing
 - b. format of material:
 - ☐ on paper
 - ☐ in electronic form
 - c. time of filing/furnishing:
 - ☐ contained in the international application as filed.
 - ☐ filed together with the international application in electronic form.
 - ☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US2006/014584

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	1-42
	No: Claims	
Inventive step (IS)	Yes: Claims	
	No: Claims	1-42
Industrial applicability (IA)	Yes: Claims	1-42
	No: Claims	

2. Citations and explanations

see separate sheet

Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

see separate sheet

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

see separate sheet

Reference is made to the following documents:

D1: US-B1-6 330 317 (GARFINKEL DEAN) 11 December 2001 (2001-12-11)

D2: US 2004/109557 A1 (LENARD ROHAN) 10 June 2004 (2004-06-10)

Re Item V

**Reasoned statement with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement**

1. **Claim 1** does not meet the requirements of Article 33(3) PCT due to the subject-matter therein lacking in inventive step.

Document D1, which is considered to represent the most relevant state of the art, discloses a system for blocking calls of telemarketers according to do-not-call lists, whilst taking into account pre-existing customers, who may still legally be contacted (abstract). With respect to many of the features of claim 1 of the current application, it comprises (the references in parentheses relating to D1):

- A control system for selectively prohibiting a communications connection between an origin and destination within a communications network (abstract), the system comprising:
 - at least one list of prohibited destination identifiers (col 5, lines 54-62);
 - at least one list of exempted destination identifiers (col 6, lines 2-11);
 - a control unit that prohibits or allows the communications connection between the origin and destination based on the lists of prohibited and exempted destination identifiers ~~and preference designations corresponding to destination identifiers~~ (col 6, lines 21-49); and
 - a connection unit that receives or initiates a request for a communications connection between an origin and destination, the request including the

destination identifier and one or more target preferences, the connection unit capable of sending a request to the control unit and receiving an order from the control unit to prohibit or allow the communications connection (col 5, lines 21-32).

The subject matter of claim 1 of the present application **differs** from the disclosure of document D1 in that "*preference designations corresponding to destination identifiers*" are also taken into account in the blocking decision.

From this difference one may derive the objective technical **problem** of modifying the system in order to satisfy customers who only wish to be exempted from their default do-not-call status in specific circumstances.

When **addressing this problem**, the person skilled in the art would consult other documents in the field of telemarketing and in doing so discover D2, which discloses a dialler for managing outgoing contacts (abstract). In particular, D2 teaches of the consideration of customer (ie. destination) preferences when determining whether a call should be blocked (paras [0005], [0026], [0038]). When applying this teaching to the system of D1, the skilled person would thus arrive at the subject-matter of claim 1, which is consequently **not inventive**.

2. The additional features introduced by dependent claims 2-9 do not appear to add anything of inventive significance to the subject-matter of the claims to which they refer and therefore said claims do not satisfy the requirements of Article 33(3) PCT for inventive step. The reasons for this are as follows:

CI 2-6,8,9 These claims merely list alternative applications of the basic principles of the system in different contexts, all of which being either implicitly or explicitly disclosed by the cited prior art.

Claim 7 The periodic synchronisation of do-not-call and exemption lists is described by D1 (col 6, lines 50-67).

3. **Claim 10** corresponds to claim 1 with the features being reformulated in terms of method steps. Since the system was deemed to be non-inventive over the combination of D1 and D2, the associated method also falls short of the requirements of Article 33(3) PCT for the same reasons as outlined in §1 above.

Similarly, dependent claims **11-18** introduce corresponding features to those of claims 2-9 and said claims are consequently not inventive under Article 33(3) PCT since the arguments of §2 above equally apply.

4. **Claims 19-42** only serve to redefine subject-matter of previous claims using slightly different wording without introducing any substantial differences which could be considered as contributing an inventive step. Consequently, said claims also fail to meet the requirements of Article 33(3) PCT.

Re Item VII

Certain defects in the international application

1. Independent claims 1, 10, 19, 29, 41 and 42 are not in the two-part form in accordance with Rule 6.3(b) PCT.
2. The features of the claims are not provided with reference signs placed in parentheses (Rule 6.2(b) PCT).
3. Contrary to the requirements of Rule 5.1(a)(ii) PCT, the relevant background art disclosed in documents D1 and D2 is not mentioned in the description, nor are these documents identified therein.
4. According to the Guidelines IV, II - 4.17, the phrase "*are incorporated herein by reference*" on page 1 (lines 6-7), page 9 (lines 27-28), and page 10 (line 30) of the description should have been **deleted**; the content of the patents being referred to is not essential for carrying out the invention as meant by Article 5 PCT.

Re Item VIII

Certain observations on the international application

1. Although apparatus claims 1, 19, 41 and 42 and method claims 10 and 29 have been drafted as separate independent claims, they appear to relate effectively to the same subject-matter and to differ from each other only with regard to the definition of the subject-matter for which protection is sought and in respect of the terminology used for the features of that subject-matter. The aforementioned claims therefore lack conciseness and consequently do not meet the requirements of Article 6 PCT.